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6  
7 *Attorney for Plaintiff*

8  
9 **IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA**

10  
11 **DIGITAL VERIFICATION SYSTEMS,  
12 LLC**

13 Plaintiff,

14 v.

15  
16 **HONEYBOOK INC.,  
17 Defendants.**

**Case No. 5:23-cv-4240**

**Jury Trial Demanded**

18 **ORIGINAL COMPLAINT FOR PATENT INFRINGEMENT**

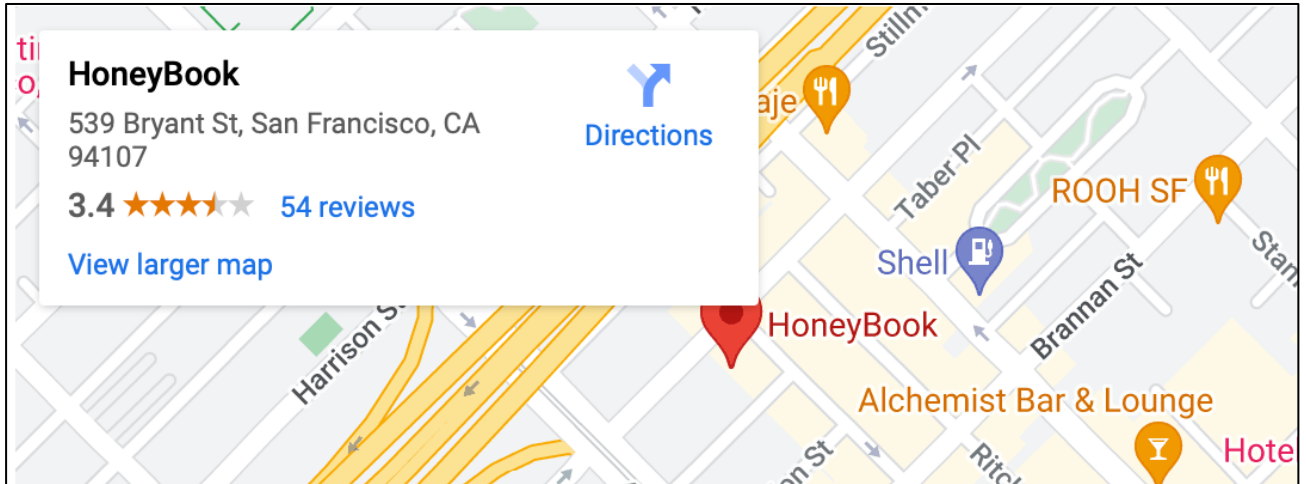
19  
20 Plaintiff Digital Verification Systems, LLC (“Plaintiff” and/or “DVS”) files this complaint against HoneyBook, Inc. (“Defendant”), for infringement of  
21 U.S. Patent No. 9,054,860 (hereinafter “the ‘860 Patent”)<sup>1</sup> and alleges as  
22 follows:  
23

24 **PARTIES**

25 1. Plaintiff is a Texas limited liability company with an address of 1  
26 East Broward Boulevard, Suite 700, Ft. Lauderdale, FL 33301.

27  
28 <sup>1</sup> The ‘860 patent expires no earlier than April 7, 2034. The DVS patent family also includes U.S. Patent Nos. 9,917,834 and 10,498,732.

2. Defendant has its United States primary place of business located at 539 Bryant St, San Francisco, CA 84107



*Figure 1 – Excerpt from HoneyBook.com website as visited last on August 14, 2023.*

### **JURISDICTION AND VENUE**

3. This action arises under the patent laws of the United States, 35 U.S.C. § 271 *et seq.* Plaintiff is seeking damages, as well as attorney fees and costs.

4. Jurisdiction is proper in this Court pursuant to 28 U.S.C. §§ 1331 (Federal Question) and 1338(a) (Patents).

5. On information and belief, this Court has personal jurisdiction over Defendant because Defendant has committed, and continues to commit, acts of infringement in this District, has conducted business in this District, and/or has engaged in continuous and systematic activities in this District.

6. Upon information and belief, Defendant's instrumentalities that are alleged herein to infringe were and continue to be used, imported, offered for sale, and/or sold in this District.

7. Venue is proper in this District under 28 U.S.C. §1400(b) because Defendant is deemed to be a resident in this District. Alternatively, acts of

1 infringement are occurring in this District and Defendant has a regular and  
2 established place of business in this District.

3 **PATENT-IN-SUIT**

4 8. On June 9, 2015, the United States Patent and Trademark Office  
5 (“USPTO”) duly and legally issued the ’860 Patent, entitled “Digital Verified  
6 Identification System and Method.” The ’860 Patent is attached as Exhibit A.

7 9. Plaintiff is the sole and exclusive owner, by assignment, of the ’860  
8 Patent.

9 10. Plaintiff possesses all rights of recovery under the ’860 Patent,  
10 including the exclusive right to recover for past, present and future infringement.

11 11. The inventor of the ’860 Patent, Mr. Leigh M. Rothschild, was  
12 Chairman and Chief Executive Officer of IntraCorp Entertainment, Inc., a  
13 consumer software company with worldwide product distribution. From October  
14 1998 through February 2004, Mr. Rothschild was also Chairman and founder of  
15 BarPoint.com, a NASDAQ publicly traded wireless company that was the leader  
16 and early creator of connecting symbology, such as barcodes, to the Internet.

17 12. Mr. Rothschild is a former presidential appointee to the High-  
18 Resolution Board for the United States under former President George H.W.  
19 Bush, and has also served as an advisor for former President Ronald Reagan. Mr.  
20 Rothschild served Governors on technology boards, served as a special advisor  
21 to then Florida Secretary of Commerce John Ellis “Jeb” Bush, and served on the  
22 IT Florida Technology Board as an appointee of former Governor John Ellis  
23 “Jeb” Bush.

24 13. Mr. Rothschild chairs the Rothschild Family Foundation, which  
25 endows outstanding charities and institutions around the world.

26 14. The ’860 Patent contains thirty-nine claims including four  
27 independent claims (claims 1, 23, 26 and 39) and thirty-five dependent claims.

28 15. The priority date of the ’860 Patent is at least as early January 2,

1 2008. As of the priority date, the inventions as claimed were novel, non-obvious,  
2 unconventional, and non-routine.

3 16. Plaintiff alleges infringement on the part of Defendant of the '860  
4 Patent.

5 17. The '860 Patent teaches a system and method for verifying and/or  
6 authenticating the identification of an entity associated with an electronic file,  
7 such as, for example, the digital signatory thereof. *See* '860 Patent, Abstract. the  
8 system and method include a module generating assembly structured to receive  
9 at least one verification data element, and at least one digital identification  
10 module structured to be associated with at least one entity. *Id.* The digital  
11 identification module is capable of being disposed or embedded within at least  
12 one electronic file. *Id.* Further, the digital identification module includes at least  
13 one primary component structured to at least partially associate the digital  
14 identification module with the entity, and one or more metadata components. *Id.*

15 18. As noted, the claims of the '860 Patent have priority date at least as  
16 early as January 2, 2008. The present invention solves problems that existed with  
17 then-existing methods for electronically signing a document. One common then-  
18 existing method of electronically signing a document included placing a forward  
19 or backward slash prior to and/or following the signatory's typed name. '860  
20 Patent, 1:26-36. Accordingly, an individual named John Doe might electronically  
21 sign a document by placing "/John Doe/" on a signature line that is typically at or  
22 near the end of the document. *Id.* These various electronic signatures or  
23 identifiers, however, are rather difficult to authenticate, and as such, it was an  
24 arduous, if not impossible task to verify and/or authenticate the identity of the  
25 signatory to a respectable degree. *Id.*

26 19. The claims of the '860 Patent overcome deficiencies existing in the  
27 art as of the date of invention, and comprise non-conventional approaches that  
28 transform the inventions as claimed into substantially more than mere abstract

1 ideas. For example, the inventive system includes a module generating assembly  
2 structured to create at least one digital identification module, wherein the digital  
3 identification module is structured to be embedded or otherwise disposed within  
4 one or more electronic files. *Id.*, 1:65-2:3. Moreover, an entity, such as a  
5 signatory of an electronic document, may communicate at least one verification  
6 data element to the module generating assembly prior to creating the digital  
7 identification module. *Id.*, 2:3-6. The verification data element(s) may include  
8 any indicia or data structured to facilitate the verification or identification of the  
9 corresponding entity. *Id.*, 2:6-9. For example, the verification data element(s)  
10 may include a username and/or password, date of birth, social security number,  
11 driver's license number, credit card number, etc. *Id.*, 2:9-12. In at least one  
12 embodiment, the digital identification module includes at least one primary  
13 component and at least one metadata component. *Id.*, 2:25-37. The primary  
14 component may include, for example, a digital representation of a signature  
15 and/or one or more reference codes, numbers, or characters. *Id.* The primary  
16 component is generally visible or perceptible to a reader, recipient, or other user  
17 of the electronic document. *Id.* In addition, the metadata components may be  
18 representative of the one or more verification data elements, or other data  
19 corresponding to the digital identification module and/or entity, including the  
20 date and time, location of the entity, etc. *Id.*

21         20. The system(s) and methods of the '860 Patent include software and  
22 hardware that do not operate in a conventional manner. For example, the  
23 software is tailored to provide functionality to perform recited steps and the  
24 hardware is configured (and/or programmed) to provide functionality recited  
25 throughout the claims of the '860 Patent.

26         21. The '860 Patent solves problems with the art that are rooted in  
27 computer technology and that are associated with electronically signing a  
28 document. The '860 Patent claims do not merely recite the performance of some

1 business practice known from the pre-Internet world along with the requirement  
2 to perform it on the Internet.

3 22. The improvements of the '860 Patent and the features recited in the  
4 claims in the '860 Patent provide improvements to conventional hardware and  
5 software systems and methods. The improvements render the claimed invention  
6 of the '860 Patent non-generic in view of conventional components.

7 23. The improvements of the '860 Patent and the feature recitations in  
8 the claims of the '860 Patent are not those that would be well-understood, routine,  
9 or conventional to one of ordinary skill in the art at the time of the invention.

10 24. The '860 Patent was examined by Primary United States Patent  
11 Examiner Oscar Louie. During the examination of the '860 Patent, the United  
12 States Patent Examiner searched for prior art in the following US Classifications:  
13 726/26; 713/176-180; and 380/59.

14 25. After conducting a search for prior art during the examination of the  
15 '860 Patent, the United States Patent Examiner identified and cited the following  
16 as the most relevant prior art references found during the search: US 6,757,826;  
17 US 6,895,507; US 6,948,069; US 6,978,369; US 7,047,416; US 7,603,621; US  
18 7,844,918; US 2002/0026575; US 2003/0115151; US 2003/0217275; US  
19 2005/0050462; US 2005/0160272; US 2006/0173847; US 2008/0040693; and  
20 US 2008/0082509.

21 26. After giving full proper credit to the prior art and having conducted  
22 a thorough search for all relevant art and having fully considered the most  
23 relevant art known at the time, the United States Patent Examiner allowed all of  
24 the claims of the '860 Patent to issue. In so doing, it is presumed that Examiner  
25 Louie used his knowledge of the art when examining the claims. *K/S Himpp v.*  
26 *Hear-Wear Techs., LLC*, 751 F.3d 1362, 1369 (Fed. Cir. 2014). It is further  
27 presumed that Examiner Louie had experience in the field of the invention, and  
28 that the Examiner properly acted in accordance with a person of ordinary skill.

1 *In re Sang Su Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002). In view of the  
 2 foregoing, the claims of the '860 Patent are novel and non-obvious, including  
 3 over all non-cited art which is merely cumulative with the referenced and cited  
 4 prior art. Likewise, the claims of the '860 Patent are novel and non-obvious,  
 5 including over all non-cited contemporaneous state of the art systems and  
 6 methods, all of which would have been known to a person of ordinary skill in the  
 7 art, and which were therefore presumptively also known and considered by  
 8 Examiner Louie.

9 27. The claims of the '860 Patent were all properly issued, and are valid  
 10 and enforceable for the respective terms of their statutory life through expiration,  
 11 and are enforceable for purposes of seeking damages for past infringement even  
 12 post-expiration. *See, e.g., Genetics Institute, LLC v. Novartis Vaccines and*  
 13 *Diagnostics, Inc.*, 655 F.3d 1291, 1299 (Fed. Cir. 2011) (“[A]n expired patent is  
 14 not viewed as having ‘never existed.’ Much to the contrary, a patent does have  
 15 value beyond its expiration date. For example, an expired patent may form the  
 16 basis of an action for past damages subject to the six-year limitation under 35  
 17 U.S.C. § 286”) (internal citations omitted).

18 28. The nominal expiration date for the claims of the '860 Patent is no  
 19 earlier than April 7, 2034.

## 20 **COUNT ONE**

### 21 **(Infringement of United States Patent No. 9,054,860)**

22 29. Plaintiff refers to and incorporates the allegations in Paragraphs 1 –  
 23 28, the same as if set forth herein.

24 30. This cause of action arises under the patent laws of the United States  
 25 and, in particular under 35 U.S.C. §§ 271, *et seq.*

26 31. Defendant has knowledge of its infringement of the '860 Patent, at  
 27 least as of the service of the present complaint.

28 32. The '860 Patent is valid, enforceable, and was duly issued in full

compliance with Title 35 of the United States Code.

33. Upon information and belief, Defendant has infringed and continues to infringe one or more claims, including at least Claim 1, of the '860 Patent by manufacturing, using, importing, selling, offering for sale, and/or providing (as identified in the Claim Chart attached hereto as **Exhibit B**) its product that is a process method for e-signing digital documents safely ("Product(s)"), which infringes at least Claim 1 of the '860 Patent. Defendant has infringed and continues to infringe the '860 patent either directly or through acts of contributory infringement or inducement in violation of 35 U.S.C. § 271.

Infringement Claim Chart for U.S. Pat. No. US9054860B1 (DVS) Vs. HoneyBook, Inc ("Defendant")	
Claim 1	Evidence
1. A digital verified identification system,	<p>Defendant company (HoneyBook, Inc.) is a process method for e-signing digital documents safely.</p> <div style="border: 1px solid green; padding: 10px; margin: 10px 0;"> <p><b>How do clients sign contracts electronically?</b></p> <p>Once you send an online contract using HoneyBook, your clients will be sent an email that includes a secure link to their contract. You can, of course, customize the content within the email to fit your business' brand and voice. Clients can open the contract from their laptop or mobile device, review it, initial as needed, and sign electronically using a legally binding typed or hand-drawn signature. The last step for clients to sign the contract electronically is simply to hit submit, which will then notify you that your contract has been signed. When your client is ready to receive their <a href="#">online invoice</a>, they will be able to make a direct payment through HoneyBook's <a href="#">online payment software</a>. Which is easy for you and easy for your client!</p> </div> <p>Source: <a href="https://www.honeybook.com/online-contract">https://www.honeybook.com/online-contract</a></p>

**Figure 2** – Excerpt from Exhibit B to this Original Complaint.

34. Defendant also has and continues to directly infringe, literally or under the doctrine of equivalents, one or more claims, including at least Claim 1, of the '860 Patent, by having its employees internally test and use these exemplary Products.

35. The service of this Complaint, in conjunction with the attached claim chart and references cited, constitutes actual knowledge of infringement as alleged here.

1           36. Despite such actual knowledge, Defendant continues to make, use,  
2 test, sell, offer for sale, market, and/or import into the United States, products  
3 that infringe one or more claims, including at least Claim 1, of the '860 Patent.  
4 On information and belief, Defendant has also continued to sell the exemplary  
5 Products and distribute product literature and website materials inducing end  
6 users and others to use its products in the customary and intended manner that  
7 infringes one or more claims, including at least Claim 1, of the '860 Patent. *See*  
8 Exhibit B (extensively referencing these materials to demonstrate how they direct  
9 end users to commit patent infringement).

10           37. At least since being served by this Complaint and corresponding  
11 claim chart, Defendant has actively, knowingly, and intentionally continued to  
12 induce infringement of the '860 Patent, literally or by the doctrine of equivalents,  
13 by selling exemplary Products to their customers for use in end-user products in  
14 a manner that infringes one or more claims, including at least Claim 1, of the '860  
15 Patent.

16           38. Exhibit B includes at least one chart comparing the exemplary claim  
17 1 of the '860 Patent to Defendant's exemplary Products. As set forth in this chart,  
18 the Defendant's exemplary Products practice the technology claimed by the '860  
19 Patent. Accordingly, the Defendant's exemplary Products incorporated in this  
20 chart satisfy all elements of the exemplary claim 1 of the '860 Patent.

21           39. Plaintiff therefore incorporates by reference in its allegations herein  
22 the claim chart of **Exhibit B**.

23           40. Plaintiff is entitled to recover damages adequate to compensate for  
24 Defendant's infringement.

25           41. Defendant's actions complained of herein will continue unless  
26 Defendant is enjoined by this court.

27           42. Defendant's actions complained of herein are causing irreparable  
28 harm and monetary damage to Plaintiff and will continue to do so unless and until

1 Defendant is enjoined and restrained by this Court.

2 43. Plaintiff is in compliance with 35 U.S.C. § 287.

3  
4 **DEMAND FOR JURY TRIAL**

5 24. Plaintiff, under Rule 38 of the Federal Rules of Civil Procedure,  
6 requests a trial by jury of any issues so triable by right.

7 **PRAYER FOR RELIEF**

8 WHEREFORE, Plaintiff asks the Court to:

9 (a) Enter judgment for Plaintiff on this Complaint on all cases of action  
10 asserted herein;

11 (b) Enter an Order enjoining Defendant, its agents, officers, servants,  
12 employees, attorneys, and all persons in active concert or participation with  
13 Defendant who receives notice of the order from further infringement of United  
14 States Patent No. 9,054,860 (or, in the alternative, awarding Plaintiff running  
15 royalty from the time judgment going forward);

16 (c) Award Plaintiff damages resulting from Defendant's infringement in  
17 accordance with 35 U.S.C. § 284;

18 (d) Award Plaintiff such further relief to which the Court finds Plaintiff  
19 entitled under law or equity.

20  
21 Dated: August 14, 2023

Respectfully submitted,  
GARTEISER HONEA, PLLC

23 /s/ Randall Garteiser

24 Randall Garteiser

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